

Remarks

The present response is to the Office Action mailed in the above-referenced case on October 12, 2007.

2-4.

Examiner's Response to Applicant's Arguments on the Merits

The applicant notes the examiner's responses that applicant's arguments are unpersuasive, and the common repeated theme throughout that the applicant has not shown that the references do not teach what the examiner alleges they do teach. The applicant disagrees, but will make another, more detailed effort to demonstrate that there is at least one element in applicant's independent claims that is not taught in the references, even as interpreted by the examiner.

5.

Examiner's Response to Applicant's Arguments Regarding the statutory 101 Rejection Made in the Last Action

The applicant thanks the examiner for the detailed explanation for the record of his opinion that claim 13 of the instant application, and claim 1 of US 6859212 are substantially identical. The table provided as a courtesy must have taken some time and effort to construct.

In response the applicant presents section 804(II)(A) from the MPEP, which states:

A. Statutory Double Patenting - 35 U.S.C. 101

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? **35 U.S.C. 101** prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under **35 U.S.C. 101** is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

This section says that "Same invention" means identical subject matter, not just similar subject matter, or an overlap in subject matter. See . *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

Claim 13 of the present application recites, from examiner's chart, "An interactive bill payment system...", while claim 1 of '212 recites "...a transaction module...". These recitations are not identical, even though some may reason that a transaction module might be construed to include an interactive bill-paying system. This difference alone is sufficient to avoid a statutory double-patenting rejection. But further: the examiner equates a "...first server node..." to "...an interactive main interface...". Some imagination is needed to make a case for equivalence, and the fact of the need for interpretation and imagination obviates any case for "identical", and "identical" is required.

So, one more time, these claims are far from identical, and they cannot, under Title 35 of the United States Code be legally rejected as claiming identical inventions.

Further, the applicant is aware that the examiner, while contending with applicant's arguments from the last response, has not restated the Statutory § 101 rejection, or stated in this action that the rejection is maintained; so the applicant may fairly presume that the rejection has been withdrawn. If the examiner meant to restate or maintain the rejection, then the applicant respectfully requests that the new argument made above be considered, and that the examiner consult his supervisor for an opinion as to whether the applicant's new argument is an appropriate showing of why the Statutory § 101 rejection is inappropriate, before reapplying this rejection.

Merit Rejections

8. Claims 13-23 are rejected under 35 U.S.C. 102(b) as being unpatentable over DCU Bill Payer (DCU).

The examiner states:

"Regarding claim 13, DCU sets forth an interactive bill-payment system for online management, viewing and payment on behalf of a user of itemized bills by proxy over a data-packet-network, comprising:

A first sever node connected to the network. The server node providing a service-access-point for accessing users (See, for example, the first sentence of the first paragraph of page 1);

A second server node connected to the network and accessible to the first server node, the second server node providing automated navigation to data sources subscribed to by the user, data procurement and data aggregations on behalf of the accessing users (See, for example page 1, 4' paragraph, first sentence, "Bill Payer Screen in Dial-Up PC Branch");

A bill-payment software interface installed on the first server node, the interface accessible to the accessing users connected to the data-packet network, characterized in that users accessing the first server node from the remote computer nodes interact with the bill payment interface for the purpose of viewing, managing and paying bills by

proxy using the functions of the first and second server nodes, See for example, the entire document.”

Applicant's Response

The applicant is starkly aware that the examiner believes the invention recited in claim 13 is the same as DCU, which the examiner states he has been using since 2001. Indeed, applicant's agent in this matter has been using that same system, or one much like it since about 2001 as well. In that system, hereinafter DCU, the only art applied in this action, we interact with a bank through an interactive interface, which allows us to enter information about billers, and to make payments to the billers, which are then paid by the bank. There is no itemized bill presentment to us by the bank; we enter all of the information to the bank, or at least enough information that the bank can retrieve destination identity for a payment transfer or for sending a check.

The invention in claim 13 is different than DCU in several respects, and if the examiner used DCU as he states, and we have no doubt that he does, it should be an easy case to make. So the applicant presents below the elements of claim 13, as amended, with reasoning in close proximity, the reasoning italicized for contrast:

13. An interactive bill-payment system, comprising:

No difference in the preamble to the DCU...

a first server node connected to a wide-area network, the first server node providing a service-access-point for a user;

still no difference to the DCU. The first server node is the bank's server, providing an interactive screen enabling bill payment...

a second server node connected to the network and accessible to the first server node, the second server node providing automated navigation to billing sources subscribed to by the user, collecting itemized bills and bill-related data, and providing same to the first server node; and

now there is a difference. In DCU there is the user and the bank. There is no second server node at all. This second server in applicant's invention is coupled to the bank's server (first server node), and performs a range of services that are over and above the services available in DCU. This second server browses through biller sites (such as utility providers), logs in by proxy on behalf of the user, with the user's permission, and retrieves data regarding what the user owes and when, including data itemizing the amounts owed; and the second server node, operating on behalf of the user, provides this information to the bank (first server node).

It is quite difficult to describe how what the examiner asserts is equivalent to this in DCU is actually different, when the examiner declines to state what he believes in DCU is equivalent, and just says "It's in there". It isn't in there.

The examiner states that he logs in the bank (DCU). Undoubtedly true. But that's not the log-in claimed. This second server node, which doesn't exist in DCU, logs in to biller sites on behalf of the user.

bill-payment software executing on the first server node, providing an interactive interface where the user may view and pay selected itemized bills.

again, the bills are itemized, they are retrieved by a second service automatically, by proxy for the user, and presented to the user through the bank's interactive window. Not there in DCU.

So, DCU Bill Payer (DCU), the relied-upon reference, does not offer online management, or viewing and payment on behalf of a user of itemized bills. DCU BP, as described in the document cited by the Examiner, lets users enter bill payees, their addresses, and the amounts to pay, and then a check is mailed to the other party. This is well-known prior art, upon which the instant invention improves. Following DCU, in some cases (such as newspapers) a regular payment can be scheduled online and it is paid electronically using an ACH Debit transaction or pre-authorized credit card charges. However, nothing in the reference cited by the Examiner teaches or implies that the bills are itemized. In fact, they clearly are not itemized, because the process of performing online

bill payments clearly calls for entering the date, amount and payee for each payment manually. There is no indication of electronic bill retrieval or presentment in the reference cited by the Examiner, nor is any evidence proffered that suggests such capabilities were present in 2001 (the date cited by the Examiner in connection with his use of DCU). The only way itemized bills could be managed, viewed and paid is if the bank (DCU in this case) accessed the servers of the third parties (bill payees), as taught and claimed in the instant invention, or if electronic bill presentment systems were coupled to the online bill payment system cited (which is not suggested by the Examiner or taught by the reference; for clarity, electronic bill presentment means that the third parties would automatically send electronic versions of their itemized bills to their customers who participated in participating online bill payment systems such as DCU, and then the customers would be presented with an itemized bill and could pay it). Thus DCU Bill Pay does NOT teach anything about "itemized bills" and clearly teaches away from itemized bills; yet "itemized bills" are specifically recited in the claim and constitute part of the mete and bounds of the claimed invention.

In addition, claim 13 of the instant invention recites a second server node, and "...the second server node providing automated navigation to data sources subscribed to by the user, data procurement, and data aggregation on behalf of the user..."

Nothing in the DCU BillPay system teaches such a second server node. The purpose of the second server node is to automatically navigate to data sources subscribed to by the user, said data sources being essential to the function of online bill payment as claimed (presenting to the user itemized bills clearly requires that the interface is served from the first server node AND the second server node is needed to navigate to data sources which are subscribed to by the user -- by clear logic these are separate and distinct from the bill payment user interface -- and to conduct data procurement and aggregation on behalf of the user). There are at least two modes in which this can occur as claimed in the invention -- first by collecting itemized billing data from the billing entities or payees (which is not taught by DCU) and second because one of the purposes of the instant invention is to allow a user to collect all of his bill payment activities in one place, even when more than one bank is used to pay bills. The DCU system does not automatically navigate to data sources

subscribed to by the user; even in the case where an automatic ACH transaction is performed, any other servers involved are subscribed to by the bank, not by the user.

Consumers do not subscribe to merchant cash management systems or merchant credit card systems; once they say "pay this bill for me" the process is opaque to them whether a check gets sent or some automated transfer takes place. There is no automated navigation on behalf of users, to which users subscribed, for any purpose, suggested by DCU or indeed by Kolling -- all of the art cited by the examiner to date has concerned single consumer-to-bank interfaces, which is not what the instant invention teaches or claims.

To reject claim 13 under 35 U.S.C. 102 it is necessary that all of the elements of the invention be taught in the art. The applicant has shown by fact and evidence that this is not the case, that the second server node and its functions as claimed are not taught in the art, so the § 102(b) rejection should be withdrawn.

As claim 13 is patentable to the applicant over the art cited and applied, claims 14-23, all depended directly or indirectly from claim 13 are patentable at least as depended from a patentable claim, and rejections in the action specifically directed to one or more depended claims are moot.

Summary

As all of the claims standing for examination have been shown to be patentable as amended and argued above over the art of record, applicant respectfully requests reconsideration, and that the present case be passed quickly to issue. If there are any time extensions needed beyond any extension specifically requested with this response, such extension of time is hereby requested. If there are any fees due beyond any fees paid with this amendment, authorization is given to deduct such fees from deposit account 50-0534.

Respectfully Submitted,
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